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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/846,762	05/01/2001	Robert Shea	31910.000014	5008
23387	7590	10/21/2004	EXAMINER	
Stephen B. Salai, Esq. Harter, Secrest & Emery LLP 1600 Bausch & Lomb Place Rochester, NY 14604-2711			JIMENEZ, MARC QUEMUEL	
		ART UNIT		PAPER NUMBER
				3726

DATE MAILED: 10/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	SHEA ET AL.
Examiner	Art Unit
Marc Jimenez	3726



— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 10 August 2004.
2a) This action is **FINAL**. 2b) This action is non-final.
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 6,8-14 and 27 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) Claim(s) _____ is/are allowed.
6) Claim(s) 6,8-14 and 27 is/are rejected.
7) Claim(s) _____ is/are objected to.
8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____

4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date _____

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____

DETAILED ACTION***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 6, 8-11, and 27 rejected under 35 U.S.C. 103(a) as being unpatentable over Gehrer (2,761,547) in view of Snelling (5,520,977).**

Gehrer teaches a roller for a roller assembly as used in transporting a sheet material, the roller comprising: a shaft 1, a first tire 2 mounted to the shaft 1 (col. 3, lines 45-47), the first tire 2 including a compliant core 6 fixed to the shaft 1 for rotation with the shaft 1, and a non compliant outer layer 5 fixed to the core 1 for rotation with the core 1, the circumference and diameter of the non compliant outer layer 5 remaining substantially constant (because it is made of steel, see col. 2, lines 61-64) as the outer layer rotates against an opposed surface to create the nip, and the compliant core 6 allowing radial displacement (col. 3, lines 3-18, “an eccentric relationship relative to each other”) of the outer layer relative to the shaft 1 as the outer layer 5 rotates against an opposed surface.

Gehrer teaches the invention cited with the exception of the compliant core composed of an open cell foam. It is noted, however, that Gehrer teaches that the compliant core 6 could be made of “rubber or any other suitable elastic and/or resilient substance”.

Snelling teaches a compliant core 13 made of an open cell foam (col. 4, lines 46-50).

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Gehrer with an open cell foam, in light of the teachings of Snelling, in order to provide a material capable of providing desirable compressibility characteristics, as suggested by Snelling at col. 4, lines 47-48 and as also suggested by Gehrer who teaches that the compliant core could be any other suitable elastic and/or resilient substance. Furthermore, It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have selected the claimed material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. See also *Ballas Liquidating Co. v Allied industries of Kansas, Inc.* (DC Kans) 205 USPQ 331.

Regarding claim 6, Snelling teaches that the cellular structure comprises polyurethane (col. 4, line 47).

Regarding claims 8-10, Gehrer inherently teaches a durometer between 35-60 Shore A because Gehrer uses the same material that applicant uses for the non-compliant layer, namely, a metal tube (col. 2, lines 61-64).

Regarding claim 11, Gehrer teaches that the non-compliant layer includes a metal tube (col. 2, lines 62-63).

3. **Claims 8-10** are rejected under 35 U.S.C. 103(a) as being unpatentable over Gehrer in view of Snelling as applied to claim 27 above, and further in view of Lancaster (5,451,198).

Gehrer/Snelling teach the claimed durometers of the non-compliant layer because Gehrer

teaches that the noncompliant layer is made of a metal tube which is the same material that applicant uses for the non-compliant layer (see for example claim 11 of applicant's disclosure).

Alternatively, Lancaster teaches a non-compliant layer having a durometer between 35 and 60 Shore A (col. 4, lines 3-5).

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Gehrer/Snelling with a non-compliant layer having a durometer between 35 and 60 Shore A, in light of the teachings of Lancaster, in order to provide a layer that has a better gripping surface. Furthermore, It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have selected the claimed material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. See also *Ballas Liquidating Co. v Allied industries of Kansas, Inc.* (DC Kans) 205 USPQ 331.

4. **Claim 12** is rejected under 35 U.S.C. 103(a) as being unpatentable over Gehrer in view of Snelling as applied to claim 11 above, and further in view of Sawa et al. (5,553,845).

Gehrer/Snelling teach the invention cited with the exception of having a coefficient of friction enhancing material on the metal tube.

Sawa et al. teach a coefficient of friction (abstract, lines 1-2) enhancing material 7 on a tube 4.

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Gehrer/Snelling with a coefficient of friction enhancing

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material, in light of the teachings of Sawa et al., in order to provide a surface which has good friction and is not affected by changes in temperature or humidity as suggested by Sawa et al., see abstract, lines 1-3.

5. **Claim 13** is rejected, as best understood (because it is unclear which claim that claim 13 is dependent upon), under 35 U.S.C. 103(a) as being unpatentable over Gehrer in view of Snelling as applied to claim 27 above, and further in view of Eiji (EP 08169573).

Gehrer/Snelling teach the invention cited with the exception of using a plastic tube for the non-compliant layer.

Eiji teaches a layer of plastic **3b** over a foam layer **3a**.

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Gehrer/Snelling with a plastic tube, in light of the teachings of Eiji, in order to provide a rust proof tube. Furthermore, It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have selected the claimed material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. See also *Ballas Liquidating Co. v Allied industries of Kansas, Inc.* (DC Kans) 205 USPQ 331. It is noted that Gehrer teaches a metal tube which is what applicant claims in claim 11.

6. **Claim 14** is rejected under 35 U.S.C. 103(a) as being unpatentable over Gehrer in view of Snelling and Eiji as applied to claim 13 above, and further in view of Sawa et al.

Gehrer/Snelling/Eiji teach the invention cited with the exception of having a coefficient of friction material on the plastic tube.

Sawa et al. teach a coefficient of friction (abstract, lines 1-2) enhancing material 7 on a tube 4.

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Gehrer/Snelling/Eiji with a coefficient of friction enhancing material, in light of the teachings of Sawa et al., in order to provide a surface which has good friction and is not affected by changes in temperature or humidity as suggested by Sawa et al., see abstract, lines 1-3.

Response to Arguments

7. Applicant's arguments filed 8/10/04 have been fully considered but they are not persuasive.

8. Applicant argues that the instant invention ~~is~~ relates to a roller assembly for use in *my* transporting a sheet material through a nip formed between a roller and an opposed surface. It is noted however, that the invention is directed to a roller product and not a roller assembly. The claims are directed to the particular structure of the roll. Claim 27 recites "a roller" and "the roller comprising".

9. In response to applicant's argument that the instant invention relates to a roller assembly for use in transporting a sheet material through and that Snelling and Gehrer relates to a roller used for a purpose unlike applicant's roller, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in

order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art.

See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

10. Applicant argues that there is nothing in Snelling that would suggest using a non-compliant outer layer because doing so would destroy the efficacy of Snelling. Snelling is not the primary reference that is being modified. It is noted that Gehrer is the primary reference and Snelling is the secondary reference. The teaching in Snelling of using a open cell foam is used as the motivation for modifying the Gehrer reference. Gehrer already has a non-compliant outer layer. Gehrer has a compliant core that could be made of “rubber or any other suitable elastic and/or resilient substance”. Therefore, because Gehrer suggests that any other suitable elastic and/or resilient substance could be used as the compliant core, it would have been obvious to a person of ordinary skill in the art, at the time of the invention, to have used the open cell foam of Snelling as the compliant layer, in order to provide a suitable elastic and/or resilient substance.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Applicant note that an interview after a final rejection will not be granted unless the intended purpose and content of the interview is presented briefly, in writing (the agenda of the interview must be in writing) to clarify issues for appeal requiring only nominal further consideration. Interviews merely to restate arguments of record or to discuss new limitations will be denied. See MPEP 714.13 and 713.09.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc Jimenez whose telephone number is (703) 306-5965. The examiner can normally be reached on Monday-Friday between 5:30 a.m.-2:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (703) 308-1789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Marc Jimenez
Patent Examiner
AU 3726

MJ

October 16, 2004